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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,626	12/08/2000	G. Scott Barbieri	B0932/7158/REH	2410

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EXAMINER

LERNER, AVRAHAM H

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,626

Applicant(s)

BARBIERI ET AL.

Examiner

Avraham Lerner

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-99 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,9,13-15,17-20,24-45,49-51,53-75 and 79-99 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8,10-12,16,21-23,46-48,52 and 76-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. The Art Unit location and examiner of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Avraham Lerner in Art Unit 3611.

Information Disclosure Statement

1. Regarding the Information Disclosure Statements filed on December 10, 2001, January 14, 2002, February 1, 2002, February 16, 2002, and May 23, 2002 the references listed have not been considered because a cursory review of the excessive number of references indicates that they are not all pertinent to the claimed invention. If applicant feels that any of these references are pertinent specifically to the claimed invention, an explanation and a new Form 1449 (listing the pertinent references), should be provided so as not to inundate the Office and the application file with references that need not be considered.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means permitting movement of the elements as in claims 52 and 77, with rigid spacers as elected in paper #10 must be shown or the feature canceled from the claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 48 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification is not enabling for a device wherein the upturned end contacts the deck as currently claimed.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 2, 5-8, 10-12, 16, 21-23, 46-48, 52, and 76-78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 12 recites the limitation "the first and second upturned ends of the runner" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

8. The recitation in claim 48 of an upturned end of the runner contacts the deck is indefinite in that it is not clear how or where the upturned end contacts the deck.

9. The claims contain repeated language which render them indefinite for improperly reciting a rider as a part of the positively claimed subject matter. For example, in claim 46, line 3, "that supports" should be changed to "for supporting" to clarify that the rider of the sliding device is not a part of the subject matter which the applicant regards as his invention.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 6, 7, 10, 11, 16, 22, 46, and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Criss (U.S. Patent No. 4,138,128).

Criss discloses a sliding device comprising all elements as claimed, including a runner (e.g. forward ski 13) having at least one upturned end and a middle portion; a deck (11) elevated from the runner, the deck having an upper surface for supporting a rider; and a spacer (see Fig. 1) secured to the runner at a runner attachment position and secured to the deck at a deck attachment position so that forces applied by a rider on the deck are inherently transmitted to the runner; wherein one or both of the runner and the deck is arranged and mounted to the spacer to allow longitudinal movement (see column 3, first full paragraph) of either the runner or the deck relative to the other, and to allow adjustment of the position of the spacer relative to the runner or the deck, the angle as recited in claim 6 being between 30 and 70 degrees (Fig. 2), the upper surface of the deck being arranged for a gripping surface (28), and wherein the runner is “free to flex” relative to the deck.

12. Claims 1, 21, 23, 76, and 78 are rejected under 35 U.S.C. 102(b) as being anticipated by Carr (U.S. Patent No. 4,225,145).

Carr discloses a sliding device comprising all elements as claimed, including a runner (e.g. 50) having first and second upturned ends and an intermediate portion; a deck (2) elevated

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from the runner, the deck having an upper surface for supporting a rider; and a spacer (8) secured to the runner at a runner attachment position and secured to the deck at a deck attachment position so that forces applied by a rider on the deck are inherently transmitted to the runner; the deck being restrained from pivoting relative to the runner about an axis running in the front to back direction (see last 2 lines of abstract), wherein the runner and deck are constructed and arranged to allow riding with both the first upturned end and the second upturned end of the runner forward, and wherein the runner and deck are movable relative to each other in a longitudinal direction.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 52 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carr in view of Criss.

Carr discloses a device having all elements as claimed, as recited above in detail, except for the spacer being arranged to allow vertical adjustment of the distance between the runner and deck as claimed.

Criss discloses that it is known in the art to provide a spacer with a shock-absorbing element to improve the riding comfort for an operator of the sliding device, the shock-absorbing element permitting vertical movement between the runner and deck.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the sliding device of Carr with the shock absorbing element of Criss in order to improve the ride quality and comfort of the sliding device. As is old and well known in the vehicle art, such a modification would have absorbed impacts from rough terrain such that the control and harshness of the vehicle ride would have greatly improved, and therefore would have been obvious to one of ordinary skill in the art.

15. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Criss.

Criss discloses the claimed invention except for utilizing a foam material on the upper surface of the deck. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a foam instead of the rigid plastic deck, since it has been held to be within the general skill level of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

16. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Criss in view of Wen (U.S. Patent No. 6,293,571 B1).

Criss discloses a device comprising all elements as claimed, except for showing the deck having uplifted lateral edges.

Wen discloses that it is known in the art to provide a decked riding vehicle with uplifted lateral edges.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the deck of Criss with uplifted lateral edges as taught by Wen in order to improve the balance and support of a rider. Such a modification would decrease the

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likelihood of a rider losing balance as he puts weight toward an outer portion of the deck when turning, and therefore this increased safety by providing upturned edges would have been obvious to one of ordinary skill in the art.

Allowable Subject Matter

17. Claim 2 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avraham Lerner whose telephone number is (703) 308-0423. The examiner can normally be reached on M-F (8:15-5:45) first Wednesday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

AVRAHAM LERNER
PRIMARY EXAMINER

A. Lerner 9/8/03

September 8, 2003